REMARKS

Claims 1-43 are pending in this application. Claims 1-43 stand rejected. In light of the remarks set forth below, Applicants respectfully submit that each of the pending claims is in immediate condition for allowance.

Claims 1-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Certified Marketing Services ("CMS") in view of U.S. Patent No. 4,947,322 ("Tenma"). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

In the Appeal Brief filed June 10, 2005, which necessitated the present Office Action, Applicants argued that with respect to claim 1, CMS fails to disclose "automatically determining an amount of said labor needed to perform said store activity using said store information, said product information, said labor information, and said labor requirements. Independent claim 1 requires:

> automatically determining an amount of said labor needed to perform said store activity using said store information, said product information, said labor information and said labor requirements

The portions of the CMS materials cited by the Office are completely silent with respect to how the amount of labor is determined and what information is used in making such a determination. There is simply no disclosure or even suggestion as to how CMS determines the labor requirement, or what information it uses, let alone how the information is collected (see below).

The cited portion of the CMS material on page 1, specifically, sections 1 and 2, merely state that it provides merchandising and detailing services, not how these services are actually accomplished or administered. In fact, CMS explicitly states that "[o]ur account managers will work one-on-one with you, from inception through completion, in order to meet your goals." This statement suggests that CMS's process for determining labor requirement is a case-by-case customized process, just the opposite of the claimed automatic process.

The CMS materials cited at page 4, section 1, indicate that the process for determining the labor requirements is a custom process, individually developed, directed and supervised by the CMS account manager. Applicants respectfully submit that the customized, case-by-case, labor determination process described in the CMS materials does not fall within the scope of the claimed term.

The CMS materials cited at page 4, section 2, describe the ICAST product. As previously argued, CMS's ICAST product performs functions that occur after the labor determination has already been performed. This post labor determination step in no way teaches or suggests the claimed automatic determination of the amount of labor required to perform the store activity. Electronic systems for performing such coordination and tracking as described with respect to the ICAST system are known in the art and admitted by the Applicants.

As further described below, the CMS material cited on pages 6 and 7 relate to the collection of marketing data by CMS and do not teach or suggest anything with respect to the determination of the amount of labor needed. The data entered on pages 6 and 7 are used "[i]f you represent a company and would like more information regarding CMS services." Page 9 of the cited CMS materials describes how the laborer interfaces with CMS. In fact, laborers log in and request assignments in contrast to the claimed notifying of the parties providing labor. Again, this portion of the CMS material does not teach or suggest anything with respect to the determination of the amount of labor needed. Finally, on cited page 13, CSM describes the types of signage conversion and installation services that it performs. Again, this section of the CMS materials does not contain any disclosure of how the labor requirements for performing these functions is determined.

The automated labor determination is made "using said store information, said product information, said labor information and said labor requirements." Claim 1 further requires that all of the information used in this automatic labor determination is received electronically. Applicants respectfully submit that the electronic collection of data disclosed on pages 6 and 7 of the CMS materials is merely used for marketing purposes and is not used in CMS' labor determination process. Specifically, above section 1 on page 6, CMS specifically states that "If you represent a company and would like more information regarding CMS services, please provide the information below:" Applicants respectfully submit that one skilled in the art would interpret this web page on the CMS website to merely be a tool for collecting marketing data about potential customers. There is no disclosure or even suggestion that CMS uses this information for anything other than marketing purposes. As previously argued, the type of information captured electronically on this web page by CMS system can absolutely not be used to determine the labor required as recited in independent claim 1.

As discussed above, CMS fails to disclose electronically receiving labor requirements, said labor representing estimates of time required to perform said store activities. The Office Action admits that CMS fails to disclose automatic determination of labor requirements. See Office Action at 4. In order to cure this deficiency, the Office Action includes Tenma. However, Tenma fails to cure this deficiency.

Tenma merely discloses a system for controlling the availability of goods in which a planner can provide a satisfactory layout of goods in a short time period. Tenma is only concerned with goods layout. There is no disclosure in Tenma relating to the automatic determination of labor as explicitly recited in claim 1. As discussed above, CMS fails to determine the amount of labor needed for a location based on the information received in the automatic labor request and then automatically post the request as a contract for field workers. See Office Action at 5. The combination of CMS and Tenma fails to disclose automatically determining an amount of said labor needed to form said store activity using said store information, said product information, said labor information, and said labor requirements. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

If the Examiner persists in the assertion that merely automating a manual process is *per se* obvious, which the above-recited claim is not, Applicants request that the Examiner set forth a reference which shows such a motivation or teaching or that the Examiner submit an Examiner's Affidavit indicating that such knowledge is known by one of ordinary skill in the art in that one of ordinary skill in the art would be motivated to combine such knowledge with CMS so that the Applicants will have the opportunity to rebut such an assertion. See, M.P.E.P. § 2144.03. Without such an Affidavit, Applicants respectfully request reconsideration and withdrawal of the pending rejections.

Independent claim 19 requires:

determining a fair share of a total amount of labor needed to perform said store activity as a function of at least one of said store information, said product information, said labor information and said labor requirements

Applicants incorporate by reference the previous arguments that term "fair share" as is known in the merchandising industry is not the same as "fair share" is used generally with respect to labor. Furthermore, as described above with respect to claim 1, CMS does not describe electronically receiving the store information, the product information the labor information and the labor requirements such that it can make the fair share determination.

As CMS does not teach or suggest making a "fair share" determination, withdrawal of the rejection of independent claim 19 is therefore respectfully requested. Claims 20-31 depend from independent claim 19 and therefore contain the "fair share" limitation thereof. Applicants respectfully request withdrawal of the rejection of dependent claims 20-31 on the basis of the arguments above with respect to independent claim 19.

Claim 32 is a system implementation of the fair share method as described above with respect to claim 19. As the CMS system does not describe a first software module that determines the "fair share of labor", withdrawal of the rejection of independent claim 32 is therefore respectfully requested. Dependent claims 33-43 each depend from independent claim 32 and therefore contain the "fair share" limitation thereof. Withdrawal of the rejection of dependent claims 33-43 on the basis of the above remarks is therefore respectfully requested.

It appears that the Examiner is attempting to take official notice that "fair share" is well known in labor industries. In accordance with Patent and Trademark Office practice, an Examiner can only rely upon official notice when the facts asserted are "capable of instant and unquestionable demonstrations as being well known."

M.P.E.P. § 2144.03[a]. For this reason, "in limited circumstances, it is appropriate for an Examiner to take official notice of facts not in the record or to rely on 'a common knowledge' in making a rejection; however, such rejection should be judicially applied." M.P.E.P. § 2144.03.

The Office Action improperly takes official notice of facts of a type specifically held not to be the subject of official notice. In addition, it appears that official notice has been taken as to legal conclusions related to patentability, when official notice is only applied to facts.

The Office Action states that "fair share" is well-known in labor industries. It would have been obvious to one of ordinary skill in the art at the time of the invention to "determine hours required for each worker based on fair share requirements in order to increase the usefulness of the tool in the market by having the tool comply with labor standards." However, the issues of whether fair share allocation are routine is exactly the type of thing that official notice may not be relied upon for. See, M.P.E.P. § 2144.3[a] ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to taking of such notice," citing, In re Eynde, 480 F.2d 1364, 1307 (C.C.P.A. 1973).)

In view of the fact that the M.P.E.P. specifically states that official notice may not be used with regard to the state of the art, the Examiner is requested in the next Office Action to provide evidence that "fair share" is well known in labor industries. Of course, such evidence should have been provided in the first place to support of finding of obviousness.

Applicants have shown that the CMS system does not describe a system for automatically determining the labor required to perform a store activity. Applicants have

furthermore shown that the CMS reference does not in any way disclose, teach or suggest the determination of a "fair share" of labor required to perform the store activity. As such, Applicants respectfully submit each of the claims of the present application are patentably distinguished from the CMS reference. As each of the claims of the present application are currently in condition for allowance, such action is earnestly solicited.

With respect to claim 32, the Office Action merely asserts that CMS does not expressly disclose determining a fair share of total amount of labor needed to perform said activity. Fair share is well-known in labor industries. It would have been obvious to one of ordinary skill in the art at the time of the invention to determine hours required for each worker based on fair share requirements in order to increase the usefulness of the tool and the market by having the tool comply with labor standards. Applicants note that the Examiner has not changed the rejection in the present matter. As the finality of the rejection was withdrawn based on Applicants' arguments, the claims directed to "fair share" should be allowed.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: December 16, 2005

Respectfully submitted,

By _____
Ian R. Blum
Registration No.: 42,336
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicants

IRB/mgs